

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Patent Application No. 10/790,123

Q80167

**AMENDMENTS TO THE DRAWINGS**

Replacement Figure 3 is provided, which changes the sectional cut representation of A-A to VII-VII.

Attachment: Replacement Sheet

**REMARKS**

Claims 1-12 are pending in the application. Claims 1-7 are rejected. Claims 8-12 are newly added. As a preliminary matter, Applicant thanks for the Examiner for acknowledging Applicant's claim to Foreign Priority and for considering the references filed with the respective Information Disclosure Statements dated March 2, 2004, April 13, 2006 and September 15, 2006.

**DRAWINGS:**

The drawings are objected to because the Examiner asserts that Figure 3 should use either Arabic or Roman numerals to represent the sectional cut. Applicant hereby amends Figure 3 to change the sectional cut A-A to VII-VII. Withdrawal of the drawing objection is respectfully requested.

**SPECIFICATION:**

The Examiner objects to the Specification because the sectional view A-A should be changed to VII-VII. Applicant hereby amends the Specification to provide this change, and respectfully requests withdrawal of the objection.

**35 U.S.C. § 112:**

The Examiner objects to claims 1-7 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for the reasons set forth in sections 5 and 6 of the Office Action. Applicant hereby amends claims 1 and 4 to address the issues raised by the Examiner so that

claims 1-7 are more definite, The rejection under 35 U.S.C. § 112, second paragraph, should be withdrawn.

**35 U.S.C. § 103:**

Claims 1, 2, 4, 6 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Duff (U.S. Patent No. 5,868,175) in view of Hamasaki (EP 0987 439 A2) in view of Cametti (U.S. Patent No. 2,887,062) in view of Carey (U.S. Patent No. 6,020,667) in further view of Sugino (U.S. Patent No. 5,590,732).

The Examiner contends that Duff discloses a first housing 59 and 71, along with a second housing 72, and control device 40 disposed between the two housings. Element 39 is applied for disclosing a motor, which the Examiner asserts includes a frame 61 and 58.

Claim 1 is drawn to an electro-hydraulic power steering apparatus, including a novel and unobvious combination of elements, which may provide exemplary, beneficial aspects noted in the present Specification. The Examiner acknowledges that Duff does not disclose multiple features of the present invention including: 1) a pump disposed on the other side of the second housing; 2) a first screw for securing the frame to the first housing; 3) a second screw for securing the first housing and the second housing; and 4) the first screw and second screw being tightened from the hand of the frame, along with the multiple other features lacking from Duff, as noted on page 5 of the Office Action.

The Examiner turns to Hamasaki to allegedly make up for the deficient teachings of Duff. However, Hamasaki *does not* provide a teaching or suggestion that would have motivated one to

modify Duff to obtain the claimed features. It is well established that a rejection cannot be predicated on the mere identification of individual components of claimed limitations. (See *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000).) Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.*

Hamasaki is drawn to an electric pump apparatus having a tank cylinder and a pump. As shown in Figure 1 of Hamasaki, the tank 5 includes a reservoir R for storing operating fluid inside of the tank cylinder 5 (see paragraph 45). As a skilled artisan will appreciate, the pump of Hamasaki clearly has a different design than Duff for a specific reason. In particular, Duff is drawn to a vapor recovery unit of a fuel dispenser used in a gas pump (i.e., type of gas pump used at commercial gas stations for obtaining automobile gas), as shown in Figure 1 of Duff. Duff does not include (nor need) a reservoir for storing fluid and is configured differently for its intended purpose of vapor recovery.

There is no motivation to combine the teachings of Duff and Hamasaki. The grounds of rejection contend that one would have combined the references to “provide support for the pump,” “simplify assembly” and to “secure and align the motor and housings together,” as noted in the first full paragraph of page 6 in the Office Action.

First, in regard to providing “support” for the pump in Duff, it is clear that Duff’s pump presently has support and does not require any different support. There is no disclosure in Duff that would lead one to believe that Duff’s support is deficient, nor is there any disclosure in

Hamasaki that Hamasaki's means of supporting the pump would be beneficial (or even needed) in Duff.

Second, Applicant draws the Examiner's attention to paragraph 15 of Hamasaki that discusses the asserted "simplification of assembly." In particular, paragraph 15 of Hamasaki reads as follow:

"The present invention has been devised to solve the above-mentioned problems, and one of the objectives of the present invention is to provide an electric pump apparatus integrally having a reservoir with a pump and electric motor, by adopting a supporting configuration in which a tank cylinder, which constitutes a reservoir for storing operating fluid, is solely detachably attached to a bracket for supporting the pump and electric motor; thereby simplifying its assembly, enabling for replacement of the tank cylinder alone." (Emphasis added.)

It is clear that Hamasaki is directed to "simplifying its assembly" in regard to replacing the tank cylinder used as a fluid reservoir. As noted in Hamasaki, the tank cylinder is used as the reservoir for storing operating fluid and is detachable for that specific purpose. Thus, the assembly/disassembly of the fluid reservoir is made more simple by Hamasaki's teachings.

In contradistinction, it is clear that Duff does not utilize a liquid reservoir and has no need for such teachings. One skilled in the art would not have been motivated to modify Duff in view of any "simplification of assembly," taught in Hamasaki. Accordingly, one would not have gratuitously modified Duff to place the pump on the other side of the housing, as recited in claim 1. Moreover, it will be appreciated that placement of a pump on the other side of the asserted second housing (72) of Duff would effectively prohibit the pump from communicating with the motor, due to it being blocked by the vertical wall of the housing (72). Not to mention, any such

proposed modification would clearly require modifications which are neither taught nor suggested by the references.

Third, the asserted motivation includes modifying the references to “secure and align the motor and housings together.” Upon a review of Duff, it is clear that its motor and housing are sufficiently secured and aligned as they presently stand. There is no teaching in Duff that it needs any further securing or aligning, nor is there any disclosure in Hamasaki that would have motivated one to modify how the motor of Duff is secured or aligned.

Accordingly, for the various reasons provided above, it is respectfully submitted that one skilled in the art would not have gratuitously taken the pump of Duff and extracted it from its present position, only to place it behind the wall 72 forming the alleged second housing.

The grounds of rejection for claim 1 not only need to overcome the above note deficiencies, but then need to establish why the teachings of *three* additional references would be applied to Duff. In particular, Cametti is relied upon for allegedly disclosing a stator having a iron core. Carey is then relied upon for allegedly disclosing a frame including an inner circumferential face into which a stator core is pressed fit. Even further, Sugino is applied for allegedly disclosing a frame made of iron. Without conceding to the application of the secondary references, Applicant respectfully submits that it is clear that one would not have modified Duff in view of Hamasaki as described in detail above. The application of Cametti, Carey and Sugino fail to make up for deficient teachings of Duff and Hamasaki.

Accordingly, Applicant respectfully submits that one would not have been motivated to combine teachings of Duff, Hamasaki, Cametti, Carey and Sugino in a manner that teaches or

suggests each feature of claim 1, such that the rejection thereof under 35 U.S.C. § 103(a) should be withdrawn. The rejection of claims 2, 4, 6 and 7 should likewise be withdrawn at least by virtue of their respective dependencies upon claim 1.

*Claim 3*

Claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Duff, Hamasaki, Cametti, Carey and in further view of Sugino.

The Examiner acknowledges that the five combined references do not teach or suggest the recitations regarding the clamp screws in claim 3, and contends that this feature represents a mere duplication of parts. Applicant respectfully submits that the multiple applied references fail to teach or suggest the features of claim 1, as noted above. Thus, the application of the very same references naturally do not teach or suggest the features of claim 3, which further define the invention of claim 1. The rejection of claim 3 is respectfully requested to be withdrawn.

*Claim 5*

Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Duff, Hamasaki, Cametti, Carey, Sugino and further in view of Knife (U.S. Patent No. 4,324,532).

The Examiner acknowledges that the combination of the originally applied five references fails to teach or suggest a sealant coated on an abutment face between a first housing and a second housing, and on an abutment face between the first housing and the frame. The Examiner therefore cites Knife. Applicant respectfully submits that the application of Knife fails to make up for the deficient teachings of the originally applied references as asserted against

claim 1, such that claim 5 is deemed patentable over the applied art at least by virtue of its dependency upon claim 1.

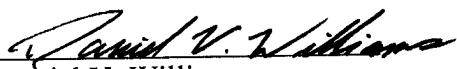
**NEW CLAIMS:**

Applicant adds new claims 8-12 to obtain more varied protection for the invention. Claims 8-12 are deemed patentable over the applied art at least by virtue of their respective dependencies upon claim 1.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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